

Amendment and Response

Applicant: Roy Stubbs

Serial No.: 10/625,353

Filed: July 23, 2003

Docket No.: M120.241.101 / 50771US006

Title: ABRASIVE MATERIALS

REMARKS

The following remarks are made in response to the Non-Final Office Action mailed February 24, 2006. In that Office Action, the Examiner rejected claims 1, 3, 4, and 5 under 35 U.S.C. §102(a) as being anticipated by German Patent No. 9407622 ("German Reference"). Claims 2, 6, and 10-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over the German Reference in view of Hong et al., U.S. Patent No. 4,202,139 ("Hong"). Claims 7-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over the German Reference in view of Hong as applied to the claims above, and further in view of Cheney et al., U.S. Patent No. 5,309,681 ("Cheney"). Claims 1-6, and 10-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hong in view of Hurst, U.S. Patent No. 2,790,533 ("Hurst"). Claims 7-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hong in view of Hurst as applied to the claims above, and further in view of Cheney.

With this Response, claims 1, 5, 7, and 13 have been amended and claim 6 has been cancelled. Claims 1-5 and 7-13 are pending in the application and are presented for reconsideration and allowance.

Support for Claim Amendments

The amendment of claim 1 is supported throughout the Specification of the instant application, for example at claim 6, FIGS. 1 and 2, page 4, lines 14-23.

The amendment of claim 5 is supported throughout the Specification of the instant application, for example in the claims as filed.

The amendment of claim 7 is supported throughout the Specification of the instant application, for example at page 3, lines 20-21 ("a direct-coated sponge abrasive material directly bearing a releasable securing means) and page 4, lines 21-23 ("In one embodiment of the invention, a layer of loop material is secured to the sponge surface and enables temporary attachment to a layer of hook material which forms part of a handle, hand strap, back-up pad, etc."); page 5, lines 25-30 ("the other major surface

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being bonded to a layer of hook or loop material, which preferably extends over the entire area of said other major surface").

The amendment of claim 13 is supported throughout the Specification of the instant application, for example at page 1, lines 17-23.

35 U.S.C. §§102 and 103 Rejections

Claim 1 stands rejected under 35 U.S.C. §102 as anticipated by the German Reference and under §103 as unpatentable over Hong in view of Hurst. Claim 1 relates, in part, to an abrading system including a direct-coated sponge abrasive material directly bearing a releasable securing means. The releasable securing means includes one part of a two part hook material and loop material attachment system. The abrasive layer comprises a coating on the surface of the sponge material together with binders which include abrasive material. The system also includes an elongate strap suitable for accommodating a hand, wherein the strap defines a first end and a second end opposite the first end, wherein the strap bears, at least at the first and second ends, the other part of the hook material or loop material of the attachment system on the first surface, and further wherein the first and second ends of the elongate strap are secured to the releasable securing means of the direct-coated sponge abrasive material. For at least the reasons described below, the cited references fail to teach or suggest such limitations.

As implicitly recognized in the Office Action, neither the German reference nor Hurst describes a strap as required by newly amended claim 1. Instead, the Office Action cites Hong as teaching a strap. However, with reference to the limitations of claim 1 as amended, it should be understood that all of the elements of claim 1 are neither taught nor suggested by the cited references. In particular, Hong describes a ring 25 that is formed by overlapping the ends of a segment of loop-type fastening material. *Hong* at col. 3, ll. 64-68; FIG. 2. As an alternative, Hong describes a fabric strap 30 that is sewn on the back side of foam pad 12. Hong makes no reference to

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using hook and loop fasteners with the fabric strap 30, but instead describes the strap as an alternative to use of hook and loop fasteners with ring 25. As such, a prima facie case of obviousness is not established for claim 1 as “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP §2143.

Claim 5 stands rejected under 35 U.S.C. §102 as anticipated by the German reference and under §103 as unpatentable over Hong in view of Hurst. Claim 5 as amended, relates, in part, to a direct-coated sponge abrasive material directly bearing a releasable securing means comprising one part of a two part hook material and loop material attachment system wherein the abrasive layer comprises a coating on the surface of the sponge material together with binders which include abrasive material, wherein the sponge is in the form of a rectangular block having two major surfaces bearing direct coated abrasive and four minor surfaces at least one of which bears said one part of said releasable securing means. For at least the reasons described below, the cited references fail to teach or suggest such limitations.

For example, none of the cited references teach or suggest “two major surfaces bearing direct coated abrasive and four minor surfaces at least one of which bears said one part of said releasable securing means.” In particular, in each instance where hook and loop fasteners are described in the cited references, they are always described as being present on a major face, and not one of four minor faces. See, e.g., *Hong* at FIG. 2, *German Reference* at FIG. 1, *Hurst* at Fig. 3. This, in fact, teaches away from at least one of four minor surfaces bearing one part of a securing means as required by claim 5 as amended. Thus, as the cited references do not teach or suggest all the limitations of claim 5 as amended, a *prima facie* case of obviousness is not established.

Claim 7 stands rejected under 35 U.S.C. §103 as unpatentable over the German Reference in view of Hong and Cheney, as well as over Hong in view of Hurst and Cheney. Claim 7 as amended relates, in part, to an abrading system including a direct-coated sponge abrasive material directly bearing a releasable securing means bonded

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onto a surface of the direct-coated sponge abrasive material, the releasable securing means comprising one part of a two part hook material and loop material attachment system wherein the abrasive layer comprises a coating on the surface of the sponge material together with binders which include abrasive material; and a back-up pad comprising the other part of a hook material and loop material attachment system. For at least the reasons described below, the cited references fail to teach or suggest such limitations.

For example, the Office Action recognizes that neither the Germany Reference nor Hong teaches a back up pad, but instead cites Cheney as teaching “a sanding pad (42) with abrasive (50) on one side and on the other side hook and loop material (53) to be attached to a back-up pad (24) via a mating surface (55) for use with a hand or powered sander.” *NFOA* at p. 3 (citing *Cheney* at abstract). However, Cheney does not teach or suggest sponge abrasive material directly bearing a releasable securing means on a surface of the direct-coated sponge abrasive material where the releasable securing means is bonded onto a surface of the direct-coated sponge abrasive material as required by the limitations of claim 7 as amended. In all embodiments except one, Cheney specifically teaches use of a “relatively stiff panel 51” between the upper major face 45 of the foam block 42 and the sheet of fibrous hook and loop attachment material 53. *Cheney* at col. 7, ll. 49-52. As such, those embodiments do not teach or suggest a releasable securing means bonded onto a surface of the direct-coated sponge abrasive material. In the one embodiment where the sheet 53a is directly associated with the block 42, Cheney describes that the relatively stiff panel 51 can be omitted, but this is in association with a set up where “[t]he block 42, can be peeled away from sheet 53a, which remains on the machine 20.” *Id.* at col. 9, ll. 1-4. Thus, the block 42 is not bonded to the sheet 53a as required by the limitations of claim 7 as amended. In fact, such releasable attachment teaches away from the limitations of claim 7 as amended. As such, a *prima facie* case of obviousness is not established.

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In sum, it has been demonstrated that each of independent claims 1, 5, and 7 are patentably distinct from the cited references. As such, withdrawal of the rejections of claims 1, 5, and 7, allowance of those claims, and notice to that effect are respectfully requested. Claims 2-4 and 8-13 depend, in some form, from one of independent claims 1, 5, or 7, respectively. As such, for at least the reasons described above in association with the independent claims, claims 2-4 and 8-13 are also believed patentable over the cited references. Withdrawal of the rejections, allowance of claims 2-4 and 8-13, and notice to that effect are respectfully requested.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-5 and 7-13 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-5 and 7-13 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either David B. Patchett at Telephone No. (651) 736-4713, Facsimile No. (651) 736-3833, or Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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3M Innovative Properties Company

P.O. Box 33427

St. Paul, MN 55133-3427

Respectfully submitted,

Roy Stubbs,

By his attorneys,

DICKE, BILLIG & CZAJA, PLLC

Fifth Street Towers, Suite 2250


100 South Fifth Street

Minneapolis, MN 55402

Telephone: (612) 573-2004

Facsimile: (612) 573-2005

Date: May 27, 2006
TAC:jmc



Timothy A. Czaja
Reg. No. 39,649

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 27th day of May, 2006.

By: 

Name: Timothy A. Czaja